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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,037	06/15/2007	Antonio Guerra	13877/20201	5826
26646 7590 01/27/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
WEDDLE, ALEXANDER MARION				
ART UNIT		PAPER NUMBER		
1792				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,037

Applicant(s)

GUERRA ET AL.

Examiner

ALEXANDER WEDDLE

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 02/16/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed February 16, 2007 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the non-compliant portions referred to therein have not been considered.

Claim Objections

2. Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP 608.01(i)-(p).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 4, 5, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 2 and 12 recite the limitation "corresponding color." "Corresponding" signifies 1 a: "having the same relationship" or 1 b: "related, accompanying" (Merriam-

Webster's Online Dictionary). Therefore, the metes and bound of claims 2 and 12 are not readily ascertainable.

6. Claim 4 recites the limitation "the top coat" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

7. Regarding Claim 5, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 5 recites the broad recitation "fibrous material", and the claim also recites "preferably of stiff parallel projecting fibres" which is a narrower statement of the range/limitation and further "such as synthetic grass fibres," which is even narrower. Furthermore, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Product-by-Process - 35 USC § 102/§ 103

35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claim 6 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bolton et al. (US 7,335,399).

Bolton et al. (US'399) teach a substrate painted with a multi-layer effect with an opaque base-layer and a semi-opaque top-layer (col. 5, lines 1-21; col. 7, lines 6-11; col. 9, lines 7-11).

In *In re Thorpe*, 227 USPQ 964 (CAFC 1985), the Examiner rejected product-by-process claims over a product, which although prepared in a different manner,

appeared to be the same (*prima facie*) as the claimed product. **Since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established.**

It is well settled that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." In *re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolton et al. (US 7,335,399) in view of Aoyama (US 5,498,670).

Regarding Claims 1-3, Bolton et al. (US'399) teach a method of painting a substrate with an emulsion paint comprising the steps of applying an opaque layer ("base coat") to a substrate and applying a pigmented emulsion paint over the opaque layer (Abstract). The opaque layer is made of an aqueous pigmented primer comprising an acrylic binder ("crosslinkable acrylic polymer") (col. 5, lines 1-8). US'399 teaches applying the pigmented emulsion paint in a semi-opaque layer, painting lightly and/ or sparingly onto the substrate in an amount sufficient to replicate a wood color, to provide darkening color to texture recesses in the substrate, and not to obscure the color of the underlying coat (col. 8, lines 42-49; col. 8, line 64 - col. 9, line 11; col. 7, lines 6-11). The colors of the opaque and the semi-opaque layers are selected so that they are of a corresponding color, i.e., should be compatibly selected or "relate to each other," so as

to provide a brilliance of color and for faithful reproduction of the desired wood coloration (col. 9, lines 22-29).

US'399 is silent as to the particle shape or size distribution. US'670 teaches that a method of forming an emulsion paint of spherical particles with an average particle diameter of 1-100 microns may be produced with a broad or with a narrow particle size distribution (col. 11, lines 10-40). US'670 teaches that the coating composition may be used as a paint to be applied to a variety of substrates for decorative finish with a good texture (col. 12, lines 48-55). It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the process of US'399 by using the method of US'670 to produce a distribution of particles in order to achieve a desired texture.

US'399 in view of US'670 fails to teach a particle size distribution in which 3 – 10% of the particles have an average particle size between 63 – 90 microns and 25 – 40 % have a particle size between 40 - 63 microns. Particle size distribution is a result-effective variable, because particle size distribution will affect the appearance and texture of the paint. It would have been obvious to a person of ordinary skill in the art at the time of invention to modify US'399 in view of US'670 by determining the optimal particle-size distribution as a result of routine optimization.

Regarding claim 4, US'399 teaches applying the emulsion paint "top coat" by brush in a cross-way fashion – at a 45 degree cross-angle to the grain (col. 10, line 66 – col. 11, line 2).

Thus Claims 1-4 *prima facie* are obvious absent evidence to the contrary.

15. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolton et al. (US 7,335,399) in view of Aoyama (US 5,498,670) as applied to claim 1 above, and further in view of Booth et al. (US 2004/0158949).

Regarding Claim 5, US'399 teaches provides examples of applicators for the top coat including a brush, sponge, cloth, or the like (col. 8, line 64 – col. 9, line 1). US'399 in view of US'670 fails to teach applying a top coat by roller. Examiner takes Official Notice that it was well-known in the art at the time of invention to apply a top coat emulsion paint to a substrate with a roller. It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the process of US'399 by using a roller, because a roller can hold more paint than a brush and paint an area more quickly.

US'399 in view of US'670 further fails to teach dragging over the freshly applied top coat a tool comprising a flat side provided with fibrous material, preferably of stiff parallel projecting fibers such as synthetic grass fibres. Booth et al. (US'949) teach a tool ("blade") comprising a flat side provided with a synthetic fibrous material ("bristles") for dragging ("applying") paint (Fig. 2; par. 0007, 0039). It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the process of US'399 in view of US'670 to use the fibrous flat side of the tool taught by US'949, because US'949 teaches that such tool is useful to apply coating material to obstructed surfaces [0013].

The combined references further fail to teach dragging the fibrous tool over the top coat subsequent to applying with a roller. It would have been obvious to a person of

ordinary skill in the art at the time of invention to modify the method of the combined references by dragging the fibrous tool over the top coat subsequent to applying with a roller in order to spread the paint to obstructed areas or create a decorative, textured finish as taught by the combined references.

16. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama (US 5,498,670).

Regarding Claim 7, US'670 teaches an emulsion paint composition comprising spherical particles with an average particle diameter of 1-100 microns, and the particles may be produced with a broad or with a narrow particle size distribution (col. 11, lines 10-40).

US'670 fail to teach a particle size distribution in which 3 – 10% of the particles have an average particle size between 63 – 90 microns and 25 – 40 % have a particle size between 40 - 63 microns. Particle size distribution is a result-effective variable, because particle size distribution will affect the appearance and texture of the paint. It would have been obvious to a person of ordinary skill in the art at the time of invention to modify US'670 by determining the optimal particle-size distribution as a result of routine optimization.

Regarding Claim 8, US'670 teaches that at least a portion of the spherical particles are polyurethane particles (col. 3, lines 33-48).

Regarding Claim 9, US'670 is silent as to the specific density of the particles. Specific density is a result-effective variable which affects the thickness and viscosity of the paint and thus the appearance of the painted top coat. It would have been obvious

to a person of ordinary skill in the art at the time of invention to modify the process of US'670 by determining the optimal specific density of the particles as a result of routine optimization.

Regarding Claim 10, US'670 teaches that the spherical particles may be pre-pigmented (col. 9, lines 25-29).

Claims 7-10 are *prima facie* obvious absent evidence to the contrary.

17. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama (US 5,498,670) as applied to claim 7 above, and further in view of McGeary ("Paintings by Dennis McGeary").

US'670 teaches that the spherical particles may contain a variety of additives, which do not defeat the intended use of the paint composition (col. 9, lines 31-34). US'670 fails to teach that the paint comprises wood fibers. McGeary ("Paintings") teaches adding wood shavings, paper, and banana stem fibers, among other additives, to paint to achieve textured paintings. It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the paint composition of US'670 by adding wood fibers as taught by McGeary in order to achieve a decorative paint for texturing a substrate.

US'670 in view of McGeary is silent on the length of the wood fibers. The length of the wood fibers is a result-effective variable, because the length affects the texture of, the appearance of, and the ease of applying the paint composition. It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the

composition of US'670 in view of McGeary by determining the optimal length of the wood fibers as a result of routine optimization.

Claim 11 is *prima facie* obvious absent evidence to the contrary.

18. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolton et al. (US 7,335,399) in view of Aoyama (US 5,498,670).

Regarding Claim 12, Bolton et al. (US'399) teach a set ("kit") which comprises an opaque aqueous acrylic coating and a semi-opaque emulsion paint (Abstract; col. 5, lines 1-8; col. 7, lines 6-11). US'399 is silent as to a set of paint products comprising the semi-opaque emulsion paint according to claim 7 and an opaque aqueous acrylic coating composition of a corresponding color.

US'399 fails to teach the composition of Claim 7. US'670 teaches an emulsion paint composition comprising spherical particles with an average particle diameter of 1-100 microns, and the particles may be produced with a broad or with a narrow particle size distribution (col. 11, lines 10-40).

US'670 fail to teach a particle size distribution in which 3 – 10% of the particles have an average particle size between 63 – 90 microns and 25 – 40 % have a particle size between 40 - 63 microns. Particle size distribution is a result-effective variable, because particle size distribution will affect the appearance and texture of the paint. It would have been obvious to a person of ordinary skill in the art at the time of invention to modify US'670 by determining the optimal particle-size distribution as a result of routine optimization.

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the set of US'399 by substituting the semi-opaque composition of US'670 for the semi-opaque composition of US'399, because US'670 teaches that the paint composition provides a textured paint layer with an excellent appearance (col. 2, lines 26-29).

Claim 12 is *prima facie* obvious absent evidence to the contrary.

19. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolton et al. (US 7,335,399) in view of Aoyama (US 5,498,670) as applied to claim 12 above, and further in view of Booth et al. (US 2004/0158949).

US'399 further teaches that the set ("kit") includes tools ("applicators") for applying the paint, including a scraper and/or a brush (Abstract). US'399 in view of US'670 fails to teach a tool with a flat side provided with fibrous material. Booth et al. (US'949) teach a tool ("blade") comprising a flat side provided with a synthetic fibrous material ("bristles") for dragging ("applying") paint (Fig. 2; par. 0007, 0039). It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the set of US'399 in view of US'670 to include the tool of US'949, because US'949 teaches that such tool is useful to apply coating material to obstructed surfaces [0013].

Claim 13 is *prima facie* obvious absent evidence to the contrary.

Conclusion

20. No Claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER WEDDLE whose telephone number is (571) 270-5346. The examiner can normally be reached on Monday-Thursday, 7:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Kornakov can be reached on (571)272-1303. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. W./
Examiner, Art Unit 1792
/Michael Kornakov/
Supervisory Patent Examiner, Art Unit 1792

